REMARKS

By this paper, the Applicant has amended Claims 1 and 19, and has added claim 24. Thus, Claims 1-24 are now pending and are presented for further examination.

I.   Discussion of Information Disclosure Statement Filed by Applicant on February 18, 2003

In paragraph 2 of the Office Action, the Examiner stated that the IDS "filed on 4/21/03 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office." *O.A. at page 2.* In response to the Examiner's assertion, the Applicant through its attorney of record contacted the Examiner telephonically and opposed the non-compliance of said IDS. The Applicant produced by facsimile to the Examiner a copy of the IDS as filed along with a returned post-card evidencing the Office's receipt of a form PTO-1449 listing 3 references on February 21, 2003, in compliance with 37 CFR .98(a)(1). In response to the Applicant's production of said filed IDS, the Examiner considered the 3 references and faxed back to Applicant a copy of the PTO-1449 initialed by the Examiner on January 14, 2004.

In view of the foregoing, the Applicant submits that the issue raised by the Examiner with respect to the filed IDS has been overcome.

II.   Discussion of Rejection of Claims 1-3, 5-12, 14-20, 22, and 23 Under 35 U.S.C. § 102(e)

In paragraph 3 of the Office action, the Examiner rejected Claims 1-3, 5-12, 14-20, 22, and 23 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,269,330 to Cidon et al. In rejecting independent Claims 1 and 19, the Examiner indicated that Cidon discloses all of the limitations of the claim. More particularly, the Examiner stated that "Cidon discloses a plurality of network analyzers (figure 1, reference 62) with the first and second analyzers are in data communication (figure 1, references 62, 30, 36; col. 10, lines 41-45)." *Id.* The Examiner further stated that Cidon discloses a "computer in data communication with the first and second analyzers (figure 1, references 62, 30, 36; col. 10, lines 41-45, testing system, i.e., computer); the computer is configured to command the two analyzers to establish link (col. 10, lines 41-49, agents within the testing system which controls the analyzers) and collect diagnostic data from link (figure 1, references 80, 96; col. 11, lines 58-67) and communicate data from first analyzer

to computer (col. 11, lines 58-67), computer is at different location from the analyzers (col. 12, lines 3-7, operator i.e., computer is remotely)." *Id.*

In rejecting independent Claim 10, the Examiner stated that "Cidon discloses establishing first and second analyzers that are connected to the network (figure 1, references 62, 30, 36; col. 10, lines 41-45); measure at least one parameter of the link (col. 11, line 5-11, i.e. the agent which resides in the switch which connects to the analyzer)". *O.A. at page 4.* The Examiner further stated that Cidon discloses "determin[ing] parameter deviation from network baseline by a predetermined threshold (col. 12, lines 43-58, traffic generator which includes analyzer that recognizes commands from testing center, col. 13, lines 14-26, sequence and time of test sequence); issue an alert in the event that the parameter deviates from the predetermined baseline of network (col. 13, lines 48-58; col. 16, lines 22-28). *Id.*

For the reasons discussed below, the Applicant respectfully submits that Cidon fails to disclose all of the limitations of each of Claims 1-3, 5-12, 14-20, 22, and 23 as required by law.

A.   The Law of Anticipation

Anticipation under Section 102 can be found only if a reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner, 778 F.2d 775 (Fed. Cir. 1985).* More particularly, a finding of anticipation requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences, 34 F.3d 1048, 1052 (Fed. Cir. 1994).* "To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim." *Brown v. 3M, 265 F.3d 1349 (Fed. Cir. 2001).* "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).*

B.   Brief Description of U.S. Patent No. 6,269,330 to Cidon et al.

Cidon discloses a method and apparatus for locating faults within and evaluation of performance of a communication network from a single central site. *Cidon at col. 2, ll. 15-31.* The Cidon testing system comprises a plurality of traffic agents coupled to nodes and/or hosts of the network for transmitting/receiving packets, establishing connections, and determining traffic statistics. *Id. at ll. 32-38.* The testing center communicates with the plurality of agents by means

of the network which is being evaluated or via connections independent of the network. _Id._ at _col. 3, ll. 33-37._ The testing center comprises a software package which ums on one of the computer hosts attached to the network, preferably, a compute host that is generally used for the task of network management. _Id._ at _col. 5, l. 66 to col. 6, l. 2._ Traffic generators 60 transmit data over network 20, and traffic analyzers 62 receive data to test the network 20. _Id._ at _col. 10, ll. 44-46._ The testing center 80 conducts test sessions by transmitting one or more commands to traffic agents 60, 62, 64, and 67 and network management (NM) agents 70. _Id._ at _col. 11, ll. 58-65; Fig. 1._ The testing center 80 receives reports from the traffic and NM agents and evaluates the network 20 based on the reports and displays test results to an operator 96. _Id._ at _col. 11, ll. 62-67._ Operator 96 may be located next to testing center 80 or may remotely login to the testing center and initiate test sessions from remote locations. _Id._ at _col. 12, ll. 3-7._

The network 20 comprises a network management station (NMS) 58 which monitors the operation of the network. Network management station 58 may generate, for example, alarms in response to faults detected in the network. _Id._ at _col. 10, ll. 36-40._ Generator 60 further comprises a packet generator 130 which generates packets (or cells in ATM networks) to be transmitted via output interface 115. Packet generator 130 generates data packets according to parameters of commands received by execution module 100. _Id._ at _col. 12, ll. 54-58._ The dedicated test information may include, for example, a sequence reference number, a packet order number that identifies the placement of a particular packet in a series of packets, and/or a time stamp. Further preferably, the test information includes timing information which indicates the amount of time which has elapsed since the transmission of a previous packet in the sequence and/or the time between the current packet and the next planned packet in the sequence. _Id._ at _col. 13, ll. 14-26._ The commands recognized by traffic generators 60 include commands which specify the data to be generated and when the data are to be transmitted. A first command may order generation and transmission of a packet, a stream of packets or a plurality of streams of packets. Such a command may include parameters, such as the addresses of the receiving traffic analyzers and/or the number of bytes in each packet. This number may be fixed, or it may be set according to a predetermined pattern or a random pattern, in accordance with statistical settings which are pre-programmed or received in the command. _Id._ at _col. 13, ll. 48-58._ Testing center 80 comprises a memory library 88 in which instruction scripts for various test sessions are stored.

Testing center 80 may automatically perform a test session according to a script stored in library 88, periodically and/or in response to one or more conditions of network 20, such as in response to alarms generated by network management system 58. Alternatively or additionally, the operator may invoke one or more scripts in library 88. *Id.* *at col. 16, ll. 22-28.*

C.   Cidon Fails to Teach or Suggest all of the Limitations of Claims 1-3, 5-12, 14-20, 22 and 23

In response to the Examiner's rejection of Claims 1-3, 5-12, 14-20, 22 and 23, the Applicant first addresses the Examiner's rejection of Claim 10, then respond to the Examiner's rejection of the remaining claims.

As noted above in rejecting Claim 10, the Examiner stated that Cidon discloses "determin[ing] parameter deviation from network baseline by a predetermined threshold (col. 12, lines 43-58, traffic generator which includes analyzer that recognizes commands from testing center, col. 13, lines 14-26, sequence and time of test sequence); issu[ing] an alert in the event that the parameter deviates from the predetermined baseline of network (col. 13, lines 48-58; col. 16, lines 22-28). *O.A. at page 4.* The Applicant submits that Cidon does not, and particularly the portions of Cidon cited by the Examiner do not, show or suggest that Cidon discloses the alleged limitations.

On one hand, Cidon discloses that its test information may include, for example, a sequence reference number, a packet order number that identifies the placement of a particular packet in a series of packets, and/or a time stamp and timing information. *Cidon at col. 13, ll. 14-26.* Further, the recitations in col. 12, ll. 43-58 fail to teach or suggest determining any parameter deviation, as recited in Claim 10. On the other hand, Claim 10 recites a method comprising determining whether a communication parameter deviates from network baseline by a predetermined threshold. The Applicant submits that Cidon fails to teach or suggest determining a parameter deviation from a network baseline by a predetermined threshold, as recited in Claim 10. The mere fact that Cidon discloses use of sequence reference number, packet order number or timing information does not suggest that the Cidon system determines whether a communication parameter deviates from a network baseline. In fact, the Applicant submits that the idea of identifying any network baseline is entirely absent from the disclosure of

Cidon. Thus, Cidon fails to teach or suggest a method comprising determining whether the communication parameter deviates from a network baseline from a predetermined threshold.

Further, the Applicant submits that Cidon fails to teach or suggest issuing an alert in the event the communication parameter deviates from the network baseline by the predetermined threshold, as recited in Claim 10. In satisfying the issuing step of Claim 10, the Examiner relied on respective citations in col. 13 and col. 16. More particularly, the Examiner relied on Cidon's disclosure that testing center 80 may automatically perform a test session in response to a network condition, such as in response to alarms generated by network management system 58. *Id.* at col. 16, ll. 22-28. Cidon states that the NMS 58 may generate, for example, alarms in response to faults detected in the network. *Id.* at col. 10, ll. 36-40. The Applicant submits that Cidon's generation of alarms in response to faults in the network does not *necessarily* indicate determining a deviation of a communication parameter from a network baseline by the predetermined threshold, as recited in Claim 10. More particularly, there is no indication anywhere in Cidon that any such faults occurred from a deviation of a communication parameter from a network baseline by a predetermined threshold. As noted above, the idea of determining any network baseline is entirely absent from the Cidon disclosure. Thus, Cidon fails to teach or suggest issuing an alert in the event the communication parameter deviates from the network baseline by the predetermined threshold, as recited in Claim 10. Further, it would not have been obvious to one of ordinary skill in the art to recognize the invention recited in Claim 10 in view of Cidon. Thus, any potential rejection of Claim 10 based on obviousness in view of Cidon cannot be sustained.

Since Cidon fails to teach every element and limitation of the claimed invention as arranged in Claim 10, a finding of anticipation cannot be sustained. *See Brown v. 3M, 265 F.3d 1349 (Fed. Cir. 2001).* Since each of Claims 11, 12, and 14-18 depends either directly or indirectly on Claim 10, the Applicant submits that those dependent claims are allowable.

As indicated above, the Applicant has amended Claims 1 and 19 to include at least one patentable limitation recited in and discussed in connection with Claim 10 above. Thus, for the at least the same reason, the Applicant submits that Claims 1 and 19 are also allowable. Since each of Claims 2, 3, 5-9, 20, 22, 23 and new Claim 24 depends either directly or indirectly on one of Claims 1 and 19, the Applicant submits that those dependent claims are allowable.

Thus, the Applicant requests that the rejection of Claims 1-3, 5-12, 14-20, 22 and 23 be withdrawn.

III.   Discussion of Rejection of Claims 4, 13, and 21 Under 35 U.S.C. § 103(a)

In paragraph 4 of the Office action, the Examiner rejected Claims 4, 13, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Cidon in view of U.S. Patent No. 5,691,976 to Engdahl. In rejecting these claims, the Examiner noted that Cidon "failed to teach the FDL between the analyzers and computers." *O.A. at page 5.* The Examiner relied on Engdahl to show that it disclosed the FDL for caputring the FDL channel data in every DS1 channel tha ttie to the clock lines (citing to *Engdahl at col. 32, ll., 11-14). Id.*

A.   The Law of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation to combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the references when combined must teach or suggest all of the claim limitations. *See M.P.E.P. § 2143.* It is well settled that "a showing of a suggestion, teaching or motivation to combine the prior art references is an 'essential component of an obviousness holding'." *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000).* The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fitch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).* "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *ATD Corp. v. Lydall, Inc., 159 F.3d 534, 546 (Fed. Cir. 1998).* For at least the reasons set forth below, the Applicant respectfully submits that there is no suggestion or motivation to combine the reference teachings, as argued by the Examiner.

B.   Engdahl Fails to Cure the Defeciencies of Cidon

As noted above, Cidon fails to teach or suggest all of the limitations of Claims 1, 10, and 19. Also, Engdahl does not, and the Examiner did not allege that Engdahl does, teach or suggest all of the limitations of Claims 1, 10, and 19. Engdahl does not cure the deficiencies of Cidon. Further, the Applicant respectfully submits that there is no suggestion or motivation to combine the reference teachings, as argued by the Examiner. Thus, it would not have been obvious to one of ordinary skill in the art to recognize the invention of Claims 1, 10 and 19 in view of any of those references.

Since Claims 4, 13, and 21 depend on Claims 1, 10 and 19, respectively, the Applicant submits that Claims 4, 13, and 21 are allowable. The Applicant respectfully requests that the rejection of those claims be withdrawn.

IV.   CONCLUSION

Applicant has endeavored to address all of the Examiner's concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, Applicant submits that the claim limitations above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.
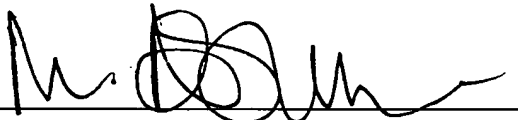
In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and, particularly, that all claims be allowed. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully invited to call the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,
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Dated: _April 2, 2004_   By: _____

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